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09/856,788	08/08/2001	Hans-Dieter Bippus	70140	3318

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Paper No. 19

Application Number: 09/856,788
Filing Date: August 08, 2001
Appellant(s): BIPPUS ET AL.

Bippus et al.
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 04-17-2003.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

Appellant asserts that each of claims 13, 14, 15, 17 and 25 are separately patentable. Claims 12 and 16 stand and fall together.

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,762,516	Itoga et al.	6-1998
EPO0766352	Petra	7-1996
DE3625240	Wieland	1-1988

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 12-17 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Petra et al (EP 0,766,352 A2) in view of Simmack (DE 3,625,240 C2).

Petra et al. disclose a shielding device comprising:

a plurality of shielding plates (24), each plate having a width wider than a width of a narrow web (32).

Petra et al. substantially disclose the claimed invention except for the plates are integrally extending from a base rail and are twisted at an angle of 90 degrees with respect to the rail.

Simmack suggests a plurality of plates (7) integrally extending from a base rail (6) and is form from a homogeneous material with the base rail.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the shielding plates integrally extending from a base rail into the shielding device of Petra et al., as taught by Simmack for quick assembling process.

(11) Response to Argument

In response to the Applicant's notice on page 5, lines 7-9, the Examiner acknowledge that the European Patent to Petral (EP 0,766,352) is equivalent to a US Patent 5,772,472.

In response to Applicant's argument on page 5, lines ~~10-14~~ 11-15, the Examiner respectfully disagrees. Petra discloses a web structure (member 32) as claimed by the applicant. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitation. *Ex Parte Masham, 2 USPQ2d 1647 (1987).*

In response to the Applicant's argument on line ~~15~~ 16 of page 5 to line ~~14~~ 11 of page 6, the examiner respectfully disagrees. The examiner is only using the teaching of Simmack, that is, a conductive member 7 connecting to a base rail 6 via a narrower twisted member or web. Therefore, Petra's shielding member could be established using the same technique taught by Simmack.

In response to the Applicant's argument on line ~~15~~ 12 of page 6 to line 3 of page 7, the Examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art.

See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this instance, it would have been an obvious the make the shielding plates integral with the base rail.

In response to the Applicant's argument on line 4 of page 7 to line 10 of page 8, the Examiner respectfully disagrees. The examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, a suggestion of combining a several parts into an integral part for quick connection or quick assembly is deemed well known in the art.

In response to the Applicant's argument on page 9 lines 1-4, the Examiner's respectfully disagrees. A combination of several parts into an integral part would have been obvious to one having ordinary skill in the art at the time the invention was made for ease of assembly, since it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art. *Howard v. Detroit Stove Works, 150 U.S. 164 (1893).*

In response to the Applicant's argument on page 9, lines 5-11, the Examiner respectfully disagrees. Simmack teaches the conductive element being formed into a busbar, see Figure 1, element 10. A skilled artisan would have been motivated to use the interconnection to provide a common ground connection.

In response to the Applicant's argument on line 12 of page 9 to line 3 of page 10, the Examiner respectfully disagrees. The examiner uses the connection design of Simmack to teach the provision of interconnection between the shielding members of Petra.

In response to the Applicant's argument on page 10, lines 4-8, the Examiner respectfully disagrees. Petra teaches the shielding plates being spaced from the insulation displacement contacts. The combination as presented teaches the claimed spacing arrangement (see Figures 1-2 of Petra).

In response to the Applicant's argument on page 10, lines 9-16, the Examiner respectfully disagrees. The combination of Petra with Simmack clearly shows Petra teaches the shielding plates being spaced from the insulation displacement contacts (see Figures 1-2 of Petra).

In response to the Applicant's argument on line 17 of page 10 to line 2 of page 11, the Examiner respectfully disagrees. Simmack discloses the use of a 90 degrees twisted to connect the conductive members (see Figure 1 of Simmack).

In response to the Applicant's argument on page 11, lines 3-12, the Examiner respectfully disagrees. Simmack discloses conductive elements including a web being connected and substantially parallel to the base rail and the shield plate (see Figure 1 of Simmack).

In response to the Applicant's argument on page 11, lines 13-21, the Examiner respectfully disagrees. Petra discloses the insulation piercing terminal contacts arranged on a first side of the housing and the shielding plates extending into the housing and being insert from the second side (or bottom side) opposite from the first side. The shielding plates integral with a base rail would also be insert from the second side. Therefore, Petra in combination with Simmack discloses the arrangement as claimed.

In conclusion, claims 12-17 and 25 do not overcome the art rejection of Petra and Simmack.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

T. Nguyen
July 21, 2003

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